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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/168,072	10/08/98	MARCHESANI	N 2413-101A

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EXAMINER
PIERCE, W

ART UNIT	PAPER NUMBER
3711	

DATE MAILED: 10/30/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/168,072

Applicant(s)

MARCHESANI, NICK

Examiner

William M Pierce

Art Unit

3711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 September 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 28-62 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 28-62 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

WILLIAM M. PIERCE
PRIMARY EXAMINER

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 18) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____.

Art Unit: 3711

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 28, 31-34, 39, 40, 57 and 59-61 are rejected under 35 U.S.C. 102(b) as being anticipated by Srichayaporn, Breeding or Shen.

Using Srichayaporn by example, in claims 28, 31, 33, 40 and 60, Srichayaporn shows providing a standard deck of cards (col. 3, ln. 56), dealing at cards from 3 to 7 (four tiles col. 3, ln. 24), players making a wager (col. 2, ln. 54), dealer and player splitting hands so that the number of cards in the other hand is not exceeded by more than one card (for a two card high hand and two card low hand shown in col. 3, ln. 25), and designating a winner for a players high hand that beats the dealers and a players low hand lower than the dealers (col. 2, ln. 65-col. 3, ln. 7). The card values for a standard deck of cards as recited in claims 32, 34, 59 and 61 is old and well known. Such is inherent in the disclosure of Srichayaporn.. Claim 39 is old to Pai Gow Poker discussed in Srichayaporn.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 29, 30, 35-38, 41, 43-56, 58 and 62 are rejected under 35 U.S.C. 103(a) as being unpatentable over Srichayaporn, Breeding or Shen as applied above and further in view of Malek and matters well known to card games.

Using Srichayaporn by example, in claims 29, 35 and 62, Srichayaporn clearly teaches providing 4 cards.

Art Unit: 3711

He is silent to the provisions of buying a replacement card. Malek teaches that buying of an additional card in wagering card games is old in order to give a player a chance to better his hand to win. As to claim 30 conditions placed on a dealer to allow him to better his hand are taught by Malek (col. 5, ln. 20) such features are well known in the art in order to allow a player to attempt to better their hand. Note 5,407,209 for an example. The nature of these conditions are considered an obvious matter of design choice since there exists nothing of record to show that any particular problem has been solved or any unexpected results achieved. The amount charged as called for in claim 36 is an obvious matter of choice. Claim 37, 46 and 47 pertain to how the game is "banked" by the house which are considered obvious matter of choice. Well known in the wagering art is paying off bets at less than "true odds" which incorporates a "house percentage", banking game formats where the house pays off at less than true odds and "player/banker" formats where the house take a percentage of wagers made between players. Claim 37 is nothing more than claiming paying odds minus the house percentage (Note discussion in Banyai Col. 1, lns 10-42). A "push" as called for in claim 38 is old and well known in wagering games. See Malek at col. 1, ln. 39 and Franklin col. 1, lns. 35-50. The conditions for a push to occur are considered an obvious matter of choice in design in how one wishes to resolve the wagers. Known is that granting or denying a push in a wagering game changes a player's odds that he may have with respect to the house. As to claim 41 and 43-45, the number of cards dealt in a Pai Gow game is considered an obvious matter of choice. Such has not been shown to be critical to applicant's invention since it has not shown where any particular problem has been solved or any unexpected results achieved. Submitted is that applicant's specification does not support the number of cards as being critical since it calls for varying embodiment in which the number of cards dealt is different. If in fact the number of cards to be dealt was critical then only that specific number (or range) would be shown as critical by the specification. Discarding in order for a player to attempt to better his dealt hand is old and well known to the art of wagering game having a poker format. The number of cards to be discarded as called for by claims 49-56 considered an obvious matter of choice in design (the obviousness of the number of cards dealt has been previously discussed).

As to claim 58, discarding is old to the game of cards as taught by Hoyles (See reference below in response to applicant's remarks. Discarding allows a player a more active control in selecting the content of his final hand. This has been used to add excitement to the game. To have added a "discard" of surplus cards in a game shown by Srichayaporn would have been obvious in order to make the game more entertaining.

Claims 42 rejected under 35 U.S.C. 103(a) as being unpatentable over Srichayaporn in view of Malek and further in view of Banyai

Art Unit: 3711

Srichayaporn does not discuss a bonus for a particular card meld. Banyai teaches giving players a "bonus payment" is a players hand is a predetermined combination (col. 3, ln. 1). To have included a payment award for a particular combination of cards dealt in a game like the one shown by Srichayaporn would have been obvious in order to add excitement to the game as taught by Banyai.

Response to Arguments

Applicant's arguments filed 9/10/01 have been fully considered but they are not persuasive.

The examiner's position is based on first giving the claims their broadest reasonable interpretation and second considering the art as a whole and what is ordinary to one skilled in the art. In considering what is old and well known to card games and wagering in general the examiner has reviewed an provided copies for applicant. As to the rank of cards, the ace can be low or high (Hoyles, pg. 219, last para) or can assume low or high at a players discretion as in the game of blackjack or the "swinging ace" as discussed on pg. 236 of Hoyles or in Round the Corner on pg. 263. The choice in ranking of cards is not considered to be a patentable advance. Wagering card game compare a plurality of cards in one hand to a plurality of cards in another hand to determine a winner. The number of cards depends on the design of the game. As in Poker one there is Three Card Monte, 5 card, 7 card, eight card or, in the simplest form, one card poker (Hoyles , pg. 258). The number of cards in a hand only changes the strategy of a game in a predictable fashion and is not considered to be an advance in the art. Discarding an drawing replacement cards is old and rudimentary to draw poker. Discarding cards not wanted to be used is known in Seven-Card Reverse (Hoyles, pg. 264), Six Card Stud (Hoyles, pg. 267) As taught by Hoyles at the bottom of pg. 231 variations are old to "speed the action" of the game and to offer "players inducements to "stay" with hands that would ordinarily be regarded as worthless". The privilege of discarding and drawing a card in its place is known in games like "Five Card Stud with Replacement" discussed on pg. 249 of Hoyles and often referred to as an "option". Purchasing replacement cards in wagering games is well known in game such as that shown by example in 5,407,209 where an additional wager is placed to received a replacement card.

In considering what is a patentable advance one must first consider what problem is being solved or whether unexpected results are being achieved. Further one must consider such is a matter of common knowledge and common sense of the person of ordinary skill in the art. (See *In re Bozek*, 416 F.2d 1385, 1390, 163 USPQ 545, 549 (CCPA 1969)). Moreover, skill is presumed on the part of those practicing in the art. See *In re Sovish*, 769 F.2d 738, 743, 226 USPQ 771, 774 (Fed. Cir. 1985) and that in evaluating a reference, it is proper to take into account not only the specific teaching of the reference(s) but also the inferences which one skilled in the art would reasonably be

Art Unit: 3711

expected to draw therefrom. In re Preda, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968). Additionally, one must observe that an artisan must be presumed to know something about the art apart from what the references disclose (see In re Jacoby, 309 F.2d, 513, 516, 135 USPQ 317, 319 (CCPA 1962)).

Specifically to claims 28-56, on pg. 16 applicant makes a first issue that Srichayaporn uses only a poker "scoring system". Such an argument is unpersuasive for the main reason that how cards are determined to be ranked is a matter of design choice. While poker rankings are well known, so too are unlimited numbers of variations. Merely changing how the cards are valued or ranked does not admit of a new invention absent some problem solved or unexpected results.

Likewise, applicant goes on to argue how his hands are split into "half" hands. Such merely pertains to the number of cards in each hand which is a matter of choice. The numbers of cards with respect to each hand is unlimited in its design variations. For example, Applicant could claim 20 cards in the top hand and 5 cards in the bottom hand and call them "quarter" hands. However, that too does not make the invention non-obvious. Presuming skill on the part of one skilled in the art, one would clearly realize from Srichayaporn, Breeding and Shen that the number of cards in each hand can vary according to any design choice.

Applicant's further issue on pg. 18 is that discarding and buying cards is new. From the teachings of the prior art set forth above at the outset of this section, examiner submits that such is not. Allowing a player to "pay" to attempt to better their hand is known to card games. To have incorporated this feature in Srichayaporn, Breeding or Shen would have been obvious in order to allow a player to pay to attempt to better his hand.

As to claims 57-62 on pg. 19 it is discussed above where the number of cards has not been shown to be critical. In Breeding and Shen, like Srichayaporn, each a number of cards split between two hands. The number of cards split between each hand is an obvious matter of choice as set forth above.

Applicant's position with respect to the issues at hand are that a "winning scheme" substantially defines and differentiates any game, new or old...as such changing a card game's winning strategy defines a new game" (pg. 24). This position has little to do whether or not a game is patentable. A game must be "non-obvious" even though it may be different. In determining what is non-obvious one must consider what is known in the art "as a whole" as well as what is taught by the applied art.

Examiner's position is not that a game cannot be patentable by changing the rules and winning scheme. However, for such to occur some particular problem or unexpected results must be achieved. For example, if a players method solved problems with cheating, prevented card counting, increased house percentage without reducing player interest or the like, such would be considered. In the instant case, applicant has not offered any

Art Unit: 3711

evidence where any problem has been solved or results achieved except those that would be expected. While the applicant discusses the odds of winning (top pg. 26), such are not unexpected. The odds of achieving a particular combination of cards (even on a draw with respect to poker as taught by Scarne's pgs. 582 and 583) are well studied and known to one of ordinary skill in the art.

Claims 34 and 61 pertain to the scoring of the cards and the examiner's position is set forth above.

Conclusion

This is a CPA of applicant's earlier application. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication and its merits should be directed to William Pierce at E-mail address bill.pierce@USPTO.gov or at telephone number (703) 308-3551.


Any inquiry not concerning the merits of the case such as **missing papers, copies, status or information** should be directed to Tech Center 3700 Customer Service Center at (703) 306-5648 where the fax number is (703) 308-7957 and the email is Customerservice3700@uspto.gov.

For **official fax** communications to be officially entered in the application the fax number is (703) 305-3579.

For **informal fax** communications the fax number is (703) 308-7769.

Any inquiry of a general nature or relating to the **status** of this application or proceeding can also be directed to the receptionist whose telephone number is (703) 308-1148.

Any inquiry concerning the **drawings** should be directed to the Drafting Division whose telephone number is (703) 305-8335.


WILLIAM M. PIERCE
PRIMARY EXAMINER